

REMARKS

Claims 1, 15, and 29 have been amended. Claims 1-42 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Provisional Double Patenting Rejection:

The Examiner rejected claims 1, 15 and 29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 20, 27, 39 and 46 of U.S. Application number 10/670,849. Applicant notes that this rejection is necessarily provisional, since the corresponding claims in the copending applications have not yet been patented. Applicant will address this rejection when and if it should become nonprovisional. Also, the Examiner should reevaluate this rejection in light of the above amendments to the claims and any amendments in the copending application.

Objection to the Specification:

The Examiner objected to the specification as allegedly failing to provide proper antecedent basis for the claimed computer-accessible storage medium of claims 15-28. Applicant traverses this objection and note that according to paragraph [0061] of the specification, numerous examples of computer-accessible media that are configured to store program instructions and/or data are provided. For example, paragraph [0061] mentions magnetic and optical media as well as various types of RAM and ROM. Each of these types of computer-accessible media is capable of storing program instructions and data, and is thus necessarily an example of a storage medium. Therefore, Applicant submits that the specification in fact provides ample antecedent support for the computer-accessible storage medium recited in the claims, and respectfully requests that the objection to the specification be withdrawn.

Section 103(a) Rejections:

The Office Action rejected claims 1-5, 8, 9, 12-19, 22, 23, 26-33, 36, 37 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over Barsness (U.S. Patent 7,337,210) [hereinafter Barsness] in view of Boni et al. (U.S. Patent 7,317,716) [hereinafter Boni], claims 6, 7, 20, 21, 34 and 35 as being unpatentable over Barsness and Boni in view of Burnley et al. (U.S. Publication 2007/0061450) [hereinafter Burnley], and claims 10, 11, 24, 25, 38 and 39 as being unpatentable over Barsness and Boni in view of Matsumoto et al. (U.S. Publication 2001/0025314) [hereinafter Matsumoto]. While Applicant traverses these rejections, to expedite issuance of a patent, Applicant has amended the independent claims for further clarity. Applicant submits that rejection of the amended independent claims would be unsupported by the cited references for at least the following reasons.

1. The cited art teaches the opposite type of state transition from that recited in the claims.

In rejecting claim 1, the Examiner asserts that Barsness discloses the claim features of detecting a computer system activity level indicative of computer system activity, determining whether the activity level exceeds an activity threshold, and responsively transitioning an instant messenger client presence state in response to determining that the activity level exceeds an activity threshold. Office Action at 5-6. The Examiner acknowledges that Barsness does not disclose that the instant messenger client presence state is transitioned to a busy state in response to determining that the activity level exceeds a threshold. Office Action at 6. However, a closer examination of Barsness reveals that Barsness not only fails to disclose transitioning to a busy state, but in fact operates according to principles that contradict the recitations of claim 1.

Barsness describes that if no user activity has occurred during an inactivity timeout period, the instant messenger availability or presence state corresponding to the user is changed to “N,” indicating that the user is not available. Barsness at col. 12, lines 20-30. By contrast, if user activity is detected during this period, the availability state

corresponding to the user is set to “Y,” indicating that the user is available. *Id.* at lines 33-35.

However, this type of operation is logically opposite to that recited in claim 1. In claim 1, when computer system activity is detected in excess of a threshold level, the instant messenger client presence state is transitioned to a busy state. This transition to a busy state is inconsistent with Barsness’s transition under similar circumstances. That is, when Barsness detects activity, the indicated state is not a busy state, but rather an available state in which the user is indicated as being receptive to messaging.

In fact, Barsness explicitly and positively states that computer system activity almost inevitably entails user availability: “The reason for this check is that it is presumed that very recent activity . . . is a very strong indicator that the user is available, and should probably override any information . . . which indicates otherwise.” *Id.* at col. 11, lines 24-29. This operational logic is entirely opposite to that required by claim 1, to the extent that Barsness not only fails to disclose numerous aspects of claim 1, but in fact operates according to opposite principles. As such, Barsness cannot serve as the basis for any combination with another prior art reference to arrive at the features of claim 1, since any such combination would necessarily alter the core principle of operation that underlies Barsness’s implementation of the availability state. If a proposed modification or combination of prior art references would change the principle of operation of a prior art reference being modified, those prior art references are insufficient to render the pending claims prima facie obvious. MPEP 2143.01.VI (citing *In re Ratti*, 270 F.2d 810 (CCPA 1959)).

2. The cited references fail to disclose transitioning an IM client presence state to a busy state in response to detecting activity of the computer system on which the IM client executes.

In rejecting claim 1, the Examiner acknowledges that Barsness fails to disclose transitioning a presence state to a busy state, and relies on Boni to disclose this feature.

Office Action at 6. While Boni does make mention of a busy state, the operation of Boni is incompatible with the recitations of claim 1.

As amended, claim 1 specifically recites that the presence state of the instant messenger client is transitioned to a busy state in response to a determination of the activity level of a computer system on which the instant messenger client is executing. That is, the state of the instant messenger client is reflective of the state of the system on which the client is executing.

By contrast, Boni is directed to the transitioning of an instant messenger presence state in response to an event that has nothing to do with the system on which an instant messenger client is executing. That is, Boni is directed to the implementation of presence state transitions in response to detected telephone activity occurring via a system that is distinct from the system executing the instant messenger client. *See* Boni, FIG. 1 and Abstract (showing phones 20 as distinct from PCs 58 and describing the general operation of translating phone network triggers to presence state information on a different system). Specifically, Boni describes that the triggering event that precipitates a busy state transition is an event that occurs with respect to phone 20, such as an “AIN off-hook immediate trigger” or another type of telephone-based trigger event. Boni at col. 8, line 58 – col. 9, line 25. Thus, Boni is not directed to detecting activity of a computer system that executes an instant messenger client, as required by amended claim 1. Rather, Boni is directed to detecting activity of a telephone system that is entirely unrelated to the system that executes an instant messenger client, and causing the instant messenger client presence state to reflect the activity of this unrelated telephone system.

Applicant notes that the remaining cited references fail to remedy the deficiencies of Bارسness and Boni with respect to amended claim 1. Similar arguments apply to independent claims 15 and 19, which have been amended to recite features similar to amended claim 1. Therefore, Applicant submits that rejection of amended independent claims 1, 15, and 29 would be unsupported by the cited references. Applicant also notes that the rejections of various ones of the dependent claims are further unsupported by the

cited references. However, as the rejections of the independent claims have been shown to be unsupported, further discussion of the dependent claims is unnecessary at this time.

CONCLUSION

Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69700/RCK.

Respectfully submitted,

/Robert C. Kowert/

Robert C. Kowert, Reg. #39,255
Attorney for Applicant

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: June 22, 2008